

#21

20720-95585

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Eugenio A. Cefali
Application No. : 08/962,027 Confirmation No.
Filed : October 31, 1997
For : INTERMEDIATE RELEASE NICOTINIC ACID
COMPOSITIONS FOR TREATING HYPERLIPIDEMIA

Group Art Unit : 1615

Examiner : Robert M. Joynes

RECEIVED

JAN 16 2003

OFFICE OF PETITIONS

Hon. Commissioner for Patents
P.O. Box 2327
Arlington, Virginia 22202

REQUEST TO CORRECT INVENTORSHIP UNDER
37 C.F.R. § 1.48(a)

Sir:

Pursuant to 37 C.F.R. § 1.48(a)(1), applicant hereby requests the Commissioner to correct inventorship of the above-identified Continuing Prosecution Application ("CPA"), filed Janaury 30, 2001, as well as its parent CPA application filed January 16, 1999 and its parent application filed October 31, 1997, all have the Serial No. 08/962,027, by adding the name of David J. Bova as a co-inventor. In support of this Petition, applicant files concurrently herewith:

- 1) A Statement Under 37 C.F.R. § 1.48(a)(2) from

David J. Bova;

2) A Statement Under 37 C.F.R. § 1.48(a)(5) from assignee's representative, Juan Rodriguez of Kos Pharmaceuticals, Inc., the assignee of the above-identified patent application with Exhibit A --A copy of an executed Assignment from Eugenio A. Cefali, recorded in the United States Patent and Trademark Office on April 3, 1998, at Reel/Frame: 9080/0471, in the above-identified patent application; and

3) A Declaration/Power of Attorney executed by the actual inventors as required by 37 C.F.R. § 1.63.

In the accompanying Transmittal Letter (submitted in duplicate), the Director is authorized to charge \$130.00 in payment of the fee for this Request set forth in 37 C.F.R. § 1.17(i), and any additional fee required in connection with this Request, or to credit any overpayment, to Deposit Account No. 50-2543 (Kos).

Respectfully submitted,

Date:

1/15/03

K Messick

Karen J. Messick (Reg. No. 46,256)
Attorney for Applicant

c/o Kos Pharmaceuticals, Inc.
1001 Brickell Bay Drive
25th Floor
Miami, Florida 33131
Tel.: (305) 523-3643

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Eugenio A. Cefali
Application No. : 08/962,027 Confirmation No.:
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STATEMENT OF DAVID J. BOVA UNDER 37 C.F.R. § 1.48(a)(2)
IN SUPPORT OF REQUEST TO CORRECT INVENTORSHIP

Sir:

I, DAVID J. BOVA, hereby declare that:

1. I make this statement in support of the Request to Correct Inventorship Pursuant to 37 C.F.R. § 1.48(a), filed in the above-identified patent application concurrently herewith.

2. Due to an error in designating inventorship, I am not listed as a co-inventor of the above-identified patent application.

3. The error of failing to include my name as a co-inventor of the above-identified patent application occurred without any deceptive intention on my part.

4. I hereby further declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine, or imprisonment, or both, under Section 1001, Title 18, United States Code, and that such willful false statements may jeopardize the validity of the above-identified patent application, or any patent issuing thereon.

1/8/03

Date

David J. Bova

David J. Bova

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Eugenio A. Cefali
Application No. : 08/962,027 Confirmation No.:
Filed : October 31, 1997
For : INTERMEDIATE RELEASE NICOTINIC ACID
COMPOSITIONS FOR TREATING HYPERLIPIDEMIA

Group Art Unit : 1615

Examiner : Robert M. Joynes

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Hon. Commissioner for Patents
P.O. Box 2327
Arlington, Virginia 22202

STATEMENT OF JUAN RODRIGUEZ UNDER
37 C.F.R. §§ 1.48(a)(2) AND 3.73(b)
IN SUPPORT OF REQUEST TO CORRECT INVENTORSHIP

Sir:

I, Juan Rodriguez, am empowered to act on behalf of
Kos Pharmaceuticals, Inc., the assignee of the above-identified
patent application.

Kos Pharmaceuticals, Inc., a Florida corporation
having an office and place of business at 1001 Brickell Bay
Drive, 25th Floor, Miami, Florida 33131, is the assignee of the
entire right, title and interest in the above-identified
patent, by virtue of an Assignment from the presently named
inventor, Eugenio A. Cefali.

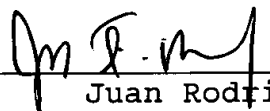
A copy of an executed Assignment from Eugenio A. Cefali, in the above-identified application, which I am informed and believe was recorded in the United States Patent and Trademark Office on April 3, 1998 at Reel/Frame: 9080/0471, is attached hereto as Exhibit A.

Kos Pharmaceuticals, Inc. hereby consents to correction of the inventorship of the above-identified patent application by the addition of David J. Bova as a co-inventor with Eugenio A. Cefali.

Kos Pharmaceuticals, Inc.

1/10/03
Date

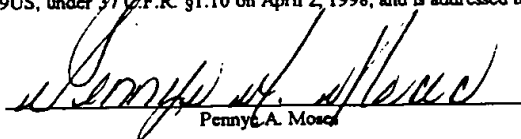
By:



Juan Rodriguez
Secretary and Vice President,
Controller
Kos Pharmaceuticals, Inc.

CERTIFICATE OF MAILING BY EXPRESS MAIL
37 C.F.R. §1.10

I hereby certify that this paper, with its indicated enclosures, is being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee", Express Mail No. EE507465869US, under 37 C.F.R. §1.10 on April 2, 1998, and is addressed to the Assistant Commissioner for Patents, Box Assignments, Washington, D.C. 20231


Penny A. Moser

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Eugenio A. Cefali
Serial No.: 08/962,027
Filing Date: October 31, 1997
Group Art Unit: 1615
Examiner: Unassigned
Title:

*Intermediate Release Nicotinic Acid Compositions for Treating
Hyperlipidemia Having Unique Cmax, Tmax and Auc
Biopharmaceutical Characteristics*

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JAN 16 2003

OFFICE OF PETITIONS

Box Assignments
Assistant Commissioner of Patents
Washington, D.C. 20231

PLEASE DOCKET
CLIENT # 32892.27
ATTY Max

COMMUNICATION

Dear Sir:

Enclosed are the following documents:

- ☒ Assignment of Entire Interest with Recordation Cover Sheet;
- ☒ Check in the amount of \$40.00 to cover the cost of the recordation fee; and
- ☒ Return postcard.


CHARGE STATEMENT: The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and may be required under 37 CFR 1.16-1.18 (missing or insufficiencies only) now or hereafter relative to this application and for the resulting Official Document under 37 CFR 1.20, OR credit any overpayment to our Deposit Account No. 10-0447/32892.27, for which purpose a duplicate copy of this sheet is attached.

Sw. of 4/10/98
file assignment 4/21/98
Due Date

This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal form is filed.

Respectfully Submitted,

Date: April 2, 1998


Peter J. Manso
Reg. No. 32,264

Jenkins & Gilchrist, P.C.
1100 Louisiana Street
Suite 1800
Houston, Texas 77002
(713) 951-3300
(713) 951-3375 (Direct Dial)
(713) 951-3314 (Fax No.)

RECORDATION FORM COVER SHEET
PATENTS ONLY

To the Honorable Commissioner of Patents and Trademarks. Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

Eugenio A. Cefali
5221 NW 78th Terrace
Lauderhill, FL 33351

Additional name(s) of conveying party(ies) attached? ☐ yes ☒ no

3. Nature of Conveyance:

- ☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Other

Execution Date: March 18, 1998

2. Name and address of receiving party(ies):

Name: Kos Pharmaceuticals, Inc.

Internal Address: 1001 South Bayshore Drive, Suite 2502
Miami, Florida 33131

Street Address: 1001 South Bayshore Drive, Suite 2502

City Miami State FL ZIP 33131

Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is:

A. Patent Application No.(s)

08/962,027

B. Patent No.(s)

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Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Peter J. Manso

Internal Address: Jenkins & Gilchrist, P.C.
1100 Louisiana, Suite 1800

Street Address: 1100 Louisiana, Suite 1800

City: Houston State: Texas ZIP: 77002

Total number of applications and patents involved: 1

7. Total fee (37 CFR 3.41): \$ 40.00

- ☐ Previously forwarded on
☒ Enclosed
☒ Authorized to be charged to deposit account.*

*If check is not received with this correspondence or additional fees are required, please charge to deposit account 10-0447/32892.27PJM.

8. Deposit account number:

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Peter J. Manso
Name of Person Signing


Signature

4/2/98
Date

Total number of pages comprising cover sheet: 1

CERTIFICATE OF MAILING 37 C.F.R. 1.10

I hereby certify that this document is being deposited with the United States Postal Service on this 2nd day of April, 1998, in an envelope as "Express Mail Post Office Addressee", Mailing Label No. EE507465869US, addressed to the Assistant Commissioner of Patents, Box Assignments, Washington, D.C. 20231.

Signature: 

Printed Name: PENNYE A. MOSES

ASSIGNMENT OF ENTIRE INTEREST

WHEREAS, I, the undersigned inventor, of residence as listed, having invented certain new and useful improvements as below entitled, for which application for United States Letters Patent is made, said application having been filed on the date set forth below; and

WHEREAS, KOS PHARMACEUTICALS, INC. (hereinafter referred to as "Assignee"), with an address of 1001 South Bayshore Drive, Suite 2502, Miami, Florida 33131, desires to acquire my entire right, title and interest in and to the invention, and in and to the said application and any Letters Patent that may issued thereon;

NOW, THEREFORE, for and in consideration of One Dollar (\$1.00) and other good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, I assign to Assignee, all right, title and interest in and to said invention and in and to said application and all patents which may be granted therefor, and all divisions, reissues, continuations, continuations-in-part and extensions thereof; and I hereby authorize and request the Commissioner of Patents and Trademarks to issue all patents for said invention, or patents resulting therefrom, insofar as my interest is concerned, to Assignee.

I also assign to Assignee, all right, title and interest to the invention disclosed in said application throughout the world, including the right to file applications and obtain patents, utility models, industrial models and designs for said invention in its own name throughout the world including all rights to publish cautionary notices reserving ownership of said invention and all rights to register said invention in appropriate registries; and I further agree to execute any and all powers of attorney, applications, assignments, declarations, affidavits, and any other papers in connection therewith necessary to perfect such right title and interest in Assignee.

I will communicate to Assignee any facts known to me respecting any improvements; and, at the expense of Assignee, I will testify in any legal proceedings, sign all lawful papers, execute all divisional, continuation, continuation-in-part, reissue and substitute applications, make lawful oaths and declarations, and generally do everything possible to vest title in Assignee and to aid Assignee to obtain and enforce proper protection for said invention in all countries.

This Assignment shall be binding on the parties' successors, assigns and legal representatives.

Title of Invention: Intermediate Release Nicotinic Acid Compositions for Treating Hyperlipidemia Having Unique Cmax, Tmax and AUC Biopharmaceutical Characteristics

Serial No.: 08/962,027
Date Filed: October 31, 1997

Signature of Inventor:

Inventor's Name: Eugenio A. Cefali
Residence: 5221 NW 78th Terrace
Lauderhill, Florida 33351
Citizenship: USA

Eugenio A. Cefali

Date:

March 18, 1998

STATE OF FLORIDA

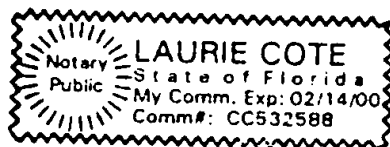
§

§

COUNTY OF BROWARD

§

BEFORE ME this 18th day of March, 1998, personally appeared EUGENIO A. CEFALI, known to me to be the person who is described and who executed the foregoing assignment instrument and acknowledged to me that he executed the same of his own free will for the purpose therein expressed.



Laurie Cote
Notary Public

FOR PATENT APPLICATION

My residence, post office address and citizenship are as stated below next to my name;

INTERMEDIATE RELEASE NICOTINIC ACID COMPOSITIONS FOR TREATING
HYPERLIPIDEMIA

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(check      []    is attached hereto
one)
```

[X] was filed on October 31, 1997 as Application No. 08/962,027 and was amended on _____.
(if applicable)

I do not know and do not believe that the invention was ever patented or described in any printed publication in any country before my or our invention thereof or more than one year prior to this application.

I acknowledge the duty to disclose to the United States Patent and Trademark Office all information known by me to be material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, § 119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's

certificate having a filing date before that of the application on which priority is claimed:

Prior Foreign Application(s)

Priority
Claimed

<u>(Number)</u>	<u>(Country)</u>	<u>(Filing Date)</u>	<u>[]</u> Yes	<u>[]</u> No
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I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s) or under § 120 and § 365(c) of the same Title to the international application(s) designating the United States listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, § 112, I acknowledge the duty to disclose to the United States Patent and Trademark Office all information known by me to be material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application:

<u>08/814,974</u> (Application No.)	<u>March 6, 1997</u> (Filing Date)	<u>Issued</u> (Status)
<u>08/368,378</u> (Application No.)	<u>January 14, 1995</u> (Filing Date)	<u>Issued</u> (Status)
<u>08/124,392</u> (Application No.)	<u>September 20, 1993</u> (Filing Date)	<u>Abandoned</u> (Status)

As a named inventor, I hereby appoint the following attorneys or agents to prosecute this application and transact all business in the United States Patent and Trademark Office connected therewith:

<u>Karen J. Messick, Esq. (Reg. No. 46,256)</u>
<u>Peter J. Manso, Esq. (Reg. No. 32,264)</u>

Send correspondence to:

Karen J. Messick, Esq.
c/o Kos Pharmaceuticals, Inc.
1001 Brickell Bay Drive
Miami, Florida 33131

Direct telephone calls to: Karen J. Messick, Esq.
(305) 523-3643

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of first joint inventor Eugenio A. Cefali

First Inventor's signature

Eugenio A. Cefali

1/8/03
Date

Residence 320 NE 12th Avenue, Fort Lauderdale, FL 33301

Citizenship U.S.A.

Post Office Address 320 NE 12th Avenue, Fort Lauderdale, FL 33301

Full name of Second Inventor David J. Boya

Second Inventor's signature

David J. Boya

1/8/03
Date

Residence 11199 Seagrass Circle, Boca Raton, FL 33498

Citizenship U.S.A.

Post Office Address 11199 Seagrass Circle, Boca Raton, FL 33498